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| 09/848,583 | 05/03/2001 | Wolfgang Matthes | A-2820 | 8707 |

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| EXAMINER | |
|---|---|
| PRONE, JASON D | |

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| 3724 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/848,583 | MATTHES ET AL. | |
| | Examiner | Art Unit | |
| | Jason Prone | 3724 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *27 May 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-4,6-11 and 14* is/are pending in the application.

4a) Of the above claim(s) *11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 6-10 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 August 2007* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because in Figure 1, the lower left corner has the numeral “10” correctly labeling the control unit. However, Figure 1 also has another occurrence of the numeral “10” in-between numerals "5" and "6". It is unclear if this is a typo or another control unit. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

2. The disclosure is objected to because of the following informalities: With regards to the paragraph spanning page 10 line 18 through page 11 line 2, the phrase "synchronous belt 15" should be replaced with "synchronous belt 23". In the same paragraph, the phrase "The knives 3 are pressed against the knives 13 during the cutting operation" should be replaced with "The knives 3 are pressed against the knives 13 during the cutting operation (the knife that interacts with knife 3 that is orientated perpendicular to the product travel direction is not shown)." A statement must be made because it is confusing to say the perpendicular knife 3 interacts with knives 13 when there is no knife 13 shown interacting with the perpendicular knife 3 and that the other knives 13 that are shown are not capable of interacting with the perpendicular knife 3.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-4, 6, 7, 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (4,922,773) in view of Besemann (4,523,502), Boss (6,536,319), and Hartlage (4,505,173). In regards to claim 1, Ito discloses the invention including a cutting station (12, 22, 49), a transport device (53) having a course of motion (Fig. 4), a first drive for driving the transport device (57), a stroke device (14 and 24) for moving knives (13 and 23) in a knife motion for performing the trimming of the margins (Column

8 lines 20-25), a second drive for driving for driving the stroke device (Drive mechanism (not shown) in Column 8 lines 20-21), and the first drive and the second drive being separate (57 is clearly independent from Drive mechanism (not shown)).

In regards to claims 2 and 3, Ito discloses the cutting device is capable of trimming margins of joined/stitched-together sheets of paper (7).

In regards to claim 4, Ito discloses the control system includes a first and second control unit (Fig. 6), the first drive being linked to the first control unit (Fig. 6), a second drive being linked to the second control unit (Fig. 6), and a connection linking the first control unit to the second control unit (73).

In regards to claims 6 and 7, Ito discloses the first drive is connected by the first control unit and the second drive by the second control unit to a machine control unit (74) and the machine control unit had a human-machine interface (71 and 72).

In regards to claim 10, the drives are motors (57 and drive mechanism) and at least one of the control units has a programmable logic controller (75 and 76).

However, Ito discloses 2 separate drives and it could be assumed that the entire apparatus including the 2 separate drives are controlled by one central computer or power source especially since the cutter must be synchronized with the conveyor, however Ito fails to disclose this fact and therefore fails to disclose both drives being connected to the other via a control system for setting the course of motion of the transport device to the knife motion as a function of product format.

Besemann teaches it is old and well known in the art of tools that include a transfer drive and a cutter drive to incorporate both drives being connected to the other

via a control system for setting the course of motion of the transport device to the knife motion as a function of product format (Column 2 lines 30-37). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have provided Ito with one control for both drives, as taught by Besemann, to allow both drives to be controlled from the same station and because all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

Also, Ito fails to disclose a first cutting station having a first cutting station having a first cutting knife, a second cutting station following the first cutting station in a transportation direction and receiving products from the first cutting station, the second cutting station having further cutting knives, the stroke device moves the knives of both stations, and the first cutting knife is perpendicular to the transport direction and the further knives are parallel to the transport direction, the first cutting station has a cutting knife, the second cutting station having cutting knives, and the first cutting knife is perpendicular to the transport direction and the further knives are parallel to the transport direction.

Boss teaches it is old and well known in the art of three-sided trimmers to incorporate a first cutting station (A), a second cutting station following the first cutting station in a transportation direction and receiving products from the first cutting station (B), the stroke device moves the knives of both stations (69), the lead knife as perpendicular to the transport direction (2) followed by the two knives parallel to the

transport direction (6, 6`). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Ito with 2 cutting stations, as taught by Boss, because all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

Further, Ito fails to disclose the transport device has front stops.

Hartlage teaches it is old and well known in the art of three-knife cutters to incorporate a transport device with front stops (13, 14). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Ito with stops, as taught by Hartlage, because all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

It is also, old and well known in the art of drive controlled structures for the control system to set the speed of the drive member driving the transport structure at speeds deemed necessary. Therefore, it would have been obvious to one of ordinary skill to all the combination structure disclosed by Ito in view of Besemann, Boss, and Hartlage to control the speed of the first drive to a speed of the products at the first stops as a function of product format. Basically, it is old and well known in the art of product speed to speed up or slow down the speed of the product based on specific perimeters (i.e. a certain speed may damage the product if it hits the stops at too fast of

a speed, therefore based on the specifications of the product, it is old and well known to determine a specific speed that would allow the product to arrive quickly and safely at the stops). The claim would have been obvious because a person of ordinary skill has good reason to pursue the known options within technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense.

5. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in view of Besemann, Boss, and Hartlage as applied to claims 1 and 4 above, and further in view of Cannon et al. (4,553,080). Ito in view of Besemann and in view of Boss disclose the invention including the first and second drives are motors (57 and drive mechanism in Ito).

However, Ito in view of Besemann, Boss, and Hartlage fail to disclose position transducers connected to the first control unit and drive and to the second control unit and drive. Cannon et al teaches that it is old and well known to exchange encoders for position transducers (Background of the Invention). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Ito in view of Besemann, Boss, and Hartlage with position transducers instead of encoders, as taught by Cannon et al., to provide more a less complex and cheaper apparatus and because all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-4, 6-10, and 14 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 5 Matthes et al. references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571)272-4513. The examiner can normally be reached on 7:30-5:00 (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

30 July 2008

/Jason Prone/

Primary Examiner, Art Unit 3724